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PATENT
Application 09/528,693
Attorney Docket 2000P07518US01 (1009-026)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1 and 21 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

U.S. Patent No. 5,596,263 ("Zavis") is incorporated by reference on page 4 of the present application. Ant, at col. 11, lines 6-8. Support for the amendments to each of claims 1 and 21 can be found, in the application as originally submitted, at least at paragraph 33 and in Zavis at least at col. 1, lines 32-41.

Each of claims 7-20 was previously cancelled without prejudice or disclaimer.

Claims 1-6 and 21-34 are now pending in this application. Each of claims 1 and 21 is in independent form.

I. The Objection to the Specification

The specification was objected to as allegedly failing to provide proper antecedent basis for claimed subject matter of "an actuator" under 37 C.F.R. §1.75(d)(1). This objection is respectfully traversed as moot in view of the present amendments to each of claims 1 and 21 that remove the phrase "an actuator" from each claim. Moreover, 37 C.F.R. §1.75(d)(1) states:

[t]he claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

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Even prior to the amendments to each of claims 1 and 21, proper antecedent basis for the claimed subject matter can be found in Zavis at least at col. 1, lines 32-41. For at least these reasons, reconsideration and withdrawal of the objection to the specification is respectfully requested.

II. The Written Description Rejections

Each of claims 1-6 and 21-34 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement, and thus was asserted to be unpatentable. Specifically, the present Office Action alleges at page 2 that the claimed phrase “programmable logic controller adapted to control an actuator” lacks support in the written description. As an initial matter, these rejections are respectfully traversed as moot in view of the present amendments to each of claims 1 and 21, which, *inter alia*, remove the phrase “an actuator”.

Moreover, “[a]dequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention ... Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.” *Ex Parte Parks*, 30 USPQ 2d 1234, 1236-37 (BPAI 1992) (citing *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1971)); see also, *In re Wright*, 866 F.2d 422, 9 USPQ 2d 1649 (Fed. Cir. 1989).

The present Office Action fails to provide any evidence whatsoever that the “originally-filed disclosure” would not have “conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.” For at least this reason, Applicant respectfully submits that the present Office Action fails to present a *prima facie* case of a failure to comply with the written description requirement of 35 U.S.C. 112.

The present Office Action merely alleges, at Pages 2-3:

[t]he specification states ‘[a] controller of particular relevance is described by Zavis et al. (U.S. Patent No. 5,596,263 and U.S. Patent No. 5,666,256) incorporated herein by reference’ (specification filed 20 March 2000, p 5, line 22-23). However, the ‘controller of particular relevance’ is unknown and unclear to a person of ordinary skill in the art. For example, does the ‘controller of

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particular relevance' refer to controller 106, line control apparatus, or controllers for a line control apparatus (Zavis 5,596,263 abstract, C2 L1-67, C3 L1-17).

Additionally, does the 'controller of particular relevance' refer to electrical apparatus 100, apparatus controller 106, or microprocessor 116 (Zavis 5,666,256 abstract, C3 L64-67). Applicant has not demonstrated possession of 'an actuator' at the time the application was filed. Appropriate correction is required.

Regarding the claimed subject matter, the present application states, at paragraph s 26-27 (emphasis added):

[i]n an aspect of the invention, the interface is provided by a human/machine interface (HMI) such as that provided by Siemens. The HMI provides a software interface to **industrial-type processors such as PLCs**. In a variation of the HMI, an internet interface is provided that automatically interfaces to the internet using the label stored in memory 200.

A **controller** of particular relevance is described by Zavis et al. (U.S. Patent No. 5,596,263 and U.S. Patent No. 5,666,256) incorporated herein by reference.

The "controller" of paragraph 27 is cited as an example of the "PLC" or programmable logic controller of paragraph 26. Zavis, which has been incorporated by reference states, at col. 1, lines 32-41 (emphasis added):

[l]ine control systems that handle larger loads often include two distinct parts: **an actuator (such as a step transformer or circuit breaker mechanism) and a controller (such as a voltage regulator controller, trip unit, or protective relay)**. The actuator includes the mechanism or other means by which the line voltage and/or current is varied (e.g. turned off, or stepped up and down). **The controller includes logic (such as a microprocessor and control program) that determines how and when the line voltage is to be varied by the actuator.**

The application as originally filed supports the claimed subject matter of each of claims 1-6 and 21-34 both prior to and subsequent to the present claim amendments. The originally-filed disclosure would have conveyed to one having ordinary skill in the art that Applicant had possession of the concept of what is claimed. For at least these reasons, Applicant respectfully requests a withdrawal of each rejection of each of claims 1-6 and 21-34.

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III. The Obviousness Rejections

Each of claims 1-6 and 21-34 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 5,804,803 ("Cragun"), U.S. Patent 6,109,526 ("Ohanian"), U.S. Patent 5,596,263 ("Zavis"), and/or U.S. Patent 6,333,973 ("Smith"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. "**Inventions** usually rely upon building blocks long since uncovered, and claimed discoveries **almost necessarily will be combinations** of what, in some sense, is already known" (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. "Granting patent protection to advances that **would occur in the ordinary course** without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility" (emphasis added).

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the "[t]he question is

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not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art". Thus, in determining obviousness, both *KSR* and *Graham* warned against a "temptation to read into the prior art the teachings of the invention in issue" and instruct to "guard against slipping into the use of hindsight".

KSR further warned, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art". The Federal Circuit has held that "[w]hen there is a design need or market pressure to solve a problem", obviousness is not supported unless "a finite, and in the context of the art, small or easily traversed, number of options" "would convince an ordinarily skilled artisan of obviousness". *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, ___ F.3d ___, 2008 WL 834402 (Fed. Cir. 2008).

To guard against hindsight, *KSR* explained the "import[ance]" of "identify[ing] a reason that would have **prompted** a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" (emphasis added). That is, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness" (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, "[t]o facilitate review, this analysis should be made explicit".

Explaining the need for "a reason that would have **prompted** a person of ordinary skill", *KSR* further taught that "if a **technique** has been used to **improve** one device, and a person of ordinary skill in the art **would recognize** that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill" (emphasis added). Further exploring this mandate, the Federal Circuit has recently recognized that "knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references". *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must "identify a reason that would have **prompted** a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular

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claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Official Notice

Regarding Official Notice, MPEP § 2144.03.A states (emphasis added):

[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable demonstration as being well-known**. For example, assertions of... specific knowledge of the prior art must

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always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Further, if an applicant traverses the examiner's assertion of Official Notice, the examiner **must provide documentary evidence** in the next Office Action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("[T]he Board cannot simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Thus, to the extent that Official Notice is explicitly or implicitly utilized to support any rejection, such as the rejection of any of claims 1-28, each such rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested.

3. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

4. Determination of the Level of Skill

Consistent with *Graham*, "the level of ordinary skill in the art is a factual question that

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must be resolved and considered.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Id.* Thus, the “examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and ‘not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand’.” MPEP 2141.03, quoting *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

B. Analysis

1. The Present Rejections are Moot

The rejections of each of claims 1-6 and 21-34 are respectfully traversed as moot in view of the present amendments to each of independent claims 1 and 21. Specifically, claim 1, from which each of claims 2-6 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “**a predetermined Profibus product** operatively coupleable to a programmable logic controller, the programmable logic controller operatively coupleable to a network, the programmable logic controller adapted to control a circuit breaker mechanism”. Claim 21, from which each of claims 22-34 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “a product information apparatus comprising an indicator, said product information apparatus communicatively coupled to **a predetermined Profibus product**, said predetermined product operatively coupleable to a programmable logic controller, said programmable logic controller adapted to control a circuit breaker mechanism”

2. The Use of Official Notice in the Rejections

Regarding Official Notice, MPEP § 2144.03.A states (emphasis added):

[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable demonstration as being well-known**. For example, assertions of... specific knowledge of the prior art must

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always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Further, if an applicant traverses the examiner's assertion of Official Notice, the examiner **must provide documentary evidence** in the next Office Action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("[T]he Board cannot simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Thus, to the extent that Official Notice is explicitly or implicitly utilized to support any rejection, such as the rejection of any of claims 1-6 and 21-34, such as the Present Office Action's rejections of each of claims 26 and 27, each such rejection is respectfully traversed as lacking evidentiary support, and citation and provision of a reference that clearly, fully, and properly supports the rejection is respectfully requested.

3. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

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4. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations and/or modifications of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine and/or modify the applied portions of the relied-upon references, that are used in rejecting each of claims 1-6 and 21-34, in such a manner so as to arrive at the claimed subject matter of each of claims 1-6 and 21-34. Regarding the proffered combinations and/or modifications of the applied portions of the relied-upon references, the present Office Action states:

- a. at pages 4-5, 7, 13, and 15, “[h]aving a programmable logic controller adapted to control an actuator such as printer would allow consumers to print out relevant product information, and enhance information delivery about the product”;
- b. at pages 8-9, “[a] suggestion exists that the micro-chip could be accessible via a serial port because this setup would eliminate using a scanning device (i.e. client computer reading the indicator directly from the micro-chip via a serial port), and speed up the process of reading the indicator”, yet no evidence of such a “suggestion” is presented;
- c. at page 9, “[a] suggestion exists that the micro-chip could be accessible via a port line (i.e. piggy backs on a port line provided with the product) because this setup would eliminate using a scanning device (i.e. client computer reading the indicator directly from the micro-chip via a port line), and speed up the process of reading the indicator”, yet no evidence of such a “suggestion” is presented;
- d. at page 9, “[a] suggestion exists that the micro-chip could be accessible via a port line (i.e. piggy backs on a port line provided with the product) because this setup would eliminate using a scanning device (i.e. client computer reading the indicator directly from the micro-chip via a port line), and speed up the process of reading the indicator”, yet no evidence of such a “suggestion” is presented;
- e. at page 10, “[a] suggestion exists that an e-mail link be present on the webpage, which sends an email to a technician responsible for handling the product, because the technician would serve a similar purpose as the additional URLs present on the

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- webpage (i.e. to provide further product information” , yet no evidence of such a “suggestion” is presented;
- f. at page 10, “[a] suggestion exists to have an on-line chat window to speak with a live technician because the technician could provide more detailed product information (e.g. medical warnings) that may not be present on the webpage” , yet no evidence of such a “suggestion” is presented;
 - g. at page 11, “[a] suggestion exists to update the maintenance log with the live technician dialog because the maintenance log should maintain a complete record of communications regarding the product” , yet no evidence of such a “suggestion” is presented;
 - h. at page 11, “[a] suggestion exists to use the product’s UPC code as an access password to the network webpage because the UPC code can verify which product the customer seeks access to on the webpage” , yet no evidence of such a “suggestion” is presented;
 - i. at pages 15-16, “[a] suggestion exists that if a connection can be made from a cell phone to a webpage via a hot-link on the cell phone, then a connection can also be made in the opposite order (from the webpage to a cell phone via a hot-link on the webpage)” , yet no evidence of such a ‘suggestion’ is presented;
 - j. at page 16, “[a] network webpage adapted to provide a hot link adapted to interface with a cell phone would allow consumers enhanced information delivery about a product, and to integrate different types of message from different types of equipment” , yet no evidence of such a “suggestion” is presented;
 - k. at pages 16-17, “[a] suggestion exists that if a connection can be made from a cell phone to a webpage via a hot-link on the cell phone, then a connection can also be made in the opposite order (from the webpage to a cell phone via a hot-link on the webpage). Furthermore, a suggestion exists that a webpage capable of a connection, or interfacing, with a cell phone via a hot-link on the webpage would also be capable of interfacing with other devices such as a utility belt”, yet no evidence of such a ‘suggestion’ is presented;

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- l. at page 17, “[a] network webpage adapted to provide a hot link adapted to interface with a utility belt would allow consumers enhanced information delivery about a product, and to integrate different types of messages from different types of equipment” , yet no evidence of such a “suggestion” is presented;
- m. at page 18, “[a] network webpage adapted to provide a hot link adapted to interface with a cell phone or utility belt would allow consumers enhanced information delivery about a product, and to integrate different types of messages from different types of equipment” , yet no evidence of such a “suggestion” is presented;

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are “a finite, and in the context of the art, small or easily traversed, number of options” that “would convince an ordinarily skilled artisan of obviousness”. Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claims 1-6 and 21-34 cannot be sustained based upon the mere conclusory statements of the present Office Action.

5. Conclusion

For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of each rejection of each of claims 1-6 and 21-34.

IV. The Erroneous Examiner’s Note

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The present Office Action makes a series of erroneous legal assertions in paragraph 67 regarding alleged “functional recitation(s)”. These assertions are respectfully traversed to the extent that they do not reflect current law.

The predecessor court to the Federal Circuit has interpreted the phrase “adapted” as preceding a “structural limitation”. *See, In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by “adapted” have been considered sufficiently definite. *See* MPEP 2173.05(g).

In addition, the Federal Circuit has interpreted the word “adapted” as preceding “functional language [that] **limits** the scope of these claims to devices that have the capability of performing the stated function. *See, R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term “adapted.”

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated “said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible in said liquid composition only after at least substantial development of the next outermost photosensitive ... layer has occurred.*” *See, In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the **functional limitations**.

In yet another case, the Federal Circuit reversed an Examiner’s rejection of a patent claim due to the Examiner’s failure to provide patentable weight to **functional limitations**. *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

To the extent that the rejections of the claims of the present application are based upon the erroneous legal standard presented by the present Office Action in paragraph 67, Applicant respectfully traverses and requests a proper claim examination.

2. Allegedly Admitted Prior Art

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Paragraph 68 of the present Office Action asserts: “[t]he Examiner notes Applicants’ admission that the following fact is well-known in the art: on-line ‘chat’ technology obtains instant access to a live technician (specification filed 20 March 2000, p 7, lines 15-17)”.

According to the Federal Circuit “[o]ne’s own work may **not** be considered prior art in the absence of a statutory basis”. *Riverwood International Corp. v. R. A. Jones & Co., Inc.*, 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003).

Page 7, lines 15-17 of the present application neither state nor admit that “on-line ‘chat’ technology” is “well-known in the art”. Instead, the present application states, “[i]n the help window, the customer, using well-known on-line ‘chat’ technology, obtains instant access to a live technician.” No evidence is of record that “on-line ‘chat’ technology” that was “well-known” to Applicant was “well-known in the art” as asserted by the present Office Action. For at least these reasons, any rejection that is based upon allegedly admitted prior art is respectfully traversed and proper evidence supporting each and every claim rejection is respectfully requested.

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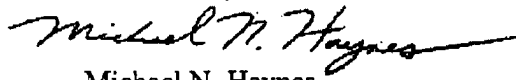
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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